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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/701,496

11/06/2003

Yutaka Tosaki

Q78309

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65565 7590 07/20/2007  
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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

07/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/701,496

Applicant(s)

TOSAKI ET AL.

Examiner

Daniel Zirker

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 103 rejection of claim 5.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 5.  
Claim(s) rejected: 1-4, 6 and 7.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

*Daniel Zirker*

Daniel Zirker  
Primary Examiner  
Art Unit: 1771

Continuation of 11. does NOT place the application in condition for allowance because: the Examiner first notes that claim 5 is objected to as it is believed to contain allowable subject matter because in addition to the multiple limitations which it already contains the presence of multiple adhesive layers (not backing layers as the applicants correctly pointed out in their Response) on one side of the sheet or backing with the outermost adhesive layer containing the specific claimed adhesive composition of claim 1 is not believed to be a structure which would be obvious to one of ordinary skill without the exercise of forbidden hindsight. As regards applicants' assertion that Cooprider et al fails to either expressly or inherently teach anticipating embodiments containing an anionic emulsifier (B) in the claimed requisite proportions present on the surface (i.e. up to 3 nm inward) of the adhesive polymer the Examiner must again respectfully disagree for reasons most of which are already of record. Note again Paragraph No. 2 of the Final Rejection, lines 1-13, which also refers back to the argument presented in the preceeding Office Action. Applicants have countered with a Declaration by a coinventor, Yutaka Tosaki, which contains a determination of whether two closely related compositions in fact would anticipate Example 8 of the patent. However, while initially the comparison appears to have convincing evidence of the strength of applicants' case the Examiner must respectfully remain unconvinced. Overlooking for the moment that the Declaration is not timely, that it is made by a clearly interested party and that technically does not even test the exact embodiment of Example 8, there still remain serious flaws. Note Cooprider et al at Column 6, lines 21-40 wherein a broad genus of operable anionic emulsifiers or surfactants is taught, including ammonium lauryl sulfate (line 39-40), the anionic surfactant or emulsifier used in Example 8. Such a showing of a single composition as not anticipating applicants' claimed invention is simply inadequate for distinguishing a genus the great breadth of which applicants claim from a genus the great breadth of which the reference discloses. As regards the addition of a hydrophilic polymer during or after polymerization (Declaration, page 2, last paragraph) as being the most significant difference it must be again noted that the reference teaches the presence of this component and, like applicants claims, does not restrict when such addition should be carried out. In summary, applicants' showing is not deemed to be commensurate in scope with the breadth of the genus he states is not anticipated by the disclosure of Cooprider et al.